

REMARKS

Election of Species

(I) In the Office Action, the Examiner requires Applicants to elect a single species of the cyclic carbonates recited in formula (I) of claim 10. Office Action at 2.

(II) The Examiner further requires Applicants to elect a method of treatment from the following groups:

- (1) Hair styling or hair shaping or making-up of hair;
- (2) Hair washing or hair care;
- (3) Hair coloring;
- (4) Eyelash treatment;
- (5) Skin treatment; and
- (6) Nail treatment.

Office Action at 2-3.

(III) Finally, the Examiner requires election of a single species of additional components from the following groups:

- (1) Fixative polymers and conditioning agents;
- (2) Dyes; and
- (3) Oxidizing agents.

Office Action at 3.

Applicants respectfully traverse the election requirements as discussed below; however, to be fully responsive, Applicants elect, with traverse:

- (I) the species of formula (I) in which:
 - (a) X is O;
 - (b) $n = 0$;

(c) R2 is S; and

(d) Z is CH₂-CH(R).

This species is disclosed, for example, in original claim 13;

(II) Group 1, drawn to methods of hair styling or hair shaping or making-up of hair; and

(III) Group 1, drawn to fixative polymers and conditioning agents as additional components.

Applicants assert that claims 1-13, 14-24, 27, and 31-34 read on the elected species. Applicants further believe the election requirements are improper as there would be no serious burden on the Examiner to examine the full scope of the claims, as set forth below.

The M.P.E.P. instructs Examiners as follows:

If the search and examination of an entire application can be made without serious burden, the Office must examine it on the merits, even though it includes claims to distinct or independent inventions.

M.P.E.P. § 803 (emphasis added).

Here, the Examiner has not shown that examining all claims together would constitute a "serious burden" as required by the M.P.E.P. With respect to election (I) among particular species of formula (I), the Examiner alleges that "formula I (claim 10) encompass[es] several cyclic carbonate compounds that are different from each other based on the substitution for the variables X, Z, R2 and R1." Office Action at 2. However, Applicants note that regardless of the identity of variables X, Z, R2 and R1, the compounds of formula (I) all belong to the cyclic carbonate class. Applicants assert that because the compounds share at least this common feature, the burden on the

Examiner in considering all species of cyclic carbonates of formula (I) would be substantially reduced.

With respect to election (II) among particular treatment methods, the Examiner asserts that the methods are “independent or distinct because a treatment for skin is different from treating nails, which is different from treating hair.” Office Action at 3. Applicants respectfully point out that the skin, nails, and hair all fall within the general class of keratinous materials. Therefore, because of this common feature, the required search for Groups 1-6 would at least partially overlap. This overlap would substantially reduce any burden on the Examiner in considering all groups in this same application.

Finally, Applicants particularly object to election (III) among various additional components. The Examiner has not set forth any reasoning at all as to why examining the full scope of the claims with respect to the additional components would constitute a serious burden. Rather, the Examiner merely notes that “treatment that involves hair coloring with dyes does not necessarily include hair conditioning ... [and] a nail composition involving dyes does not require oxidizing...” Office Action at 3. Applicant notes that regardless of the additional component selected, the composition comprises, *inter alia*, at least one cyclic carbonate. Thus, Applicant asserts that the search required for Groups 1-3, regardless of the additional component employed, would at least partially overlap and would not impose a serious burden on the Examiner. This is particularly the case in light of election (I), requiring Applicants to select a single species of cyclic carbonate.

As such, absent a showing of a serious burden in searching and examining the claims as required by the M.P.E.P, the requirements for election of species are improper and Applicants request that it be withdrawn.

If the Examiner chooses to maintain the restriction and election of species requirements, and if the elected species are found to be allowable, Applicant requests that the Examiner continue to examine the full scope of the claims to the extent necessary to determine the patentability of the pending claims. See M.P.E.P. § 803.02 and 35 U.S.C. § 121.

Conclusion

In view of the foregoing remarks, Applicant respectfully requests reconsideration and examination of the claims. Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: May 25, 2007

By: 

Thalia V. Warnement
Reg. No. 39,064